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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,980	02/17/2004	Michael H. Heggeness	89072 CIP	8886
23505	7590	12/27/2005	EXAMINER	
CONLEY ROSE, P.C.			AMARELD JR, ROBERT W	
P. O. BOX 3267			ART UNIT	
HOUSTON, TX 77253-3267			PAPER NUMBER	

3738

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/779,980	<b>Applicant(s)</b> HEGGENESS, MICHAEL H.	
	<b>Examiner</b> Robert W. Amareld, Jr.	<b>Art Unit</b> 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to a tensioner, classified in class 606, subclass 57.
- II. Claims 16-27, drawn to a bone compression plate, classified in class 606, subclass 69.
- III. Claims 28-39, drawn to a bone compression system, classified in class 606, subclass 105.

The inventions are distinct, each from the other because of the following reasons:

Inventions III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination contains the particulars of at least 3 or at least 4 arms (claims 2 & 3), a splint (claim 11) and a shaft flange (claim 14), not required by the combination. The subcombination has separate utility such as a pair of mechanical tongs use to pick up various objects.

Inventions III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §

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806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination contains the particulars of an attachment hole (claim 19) where each end has at least two holes (claim 27), not required by the combination. The subcombination has separate utility such as construction building plate for connection of two curved pieces of wood, such as in the assembly of a boat.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a pair of mechanical tongs use to pick up various objects and invention II has separate utility such as construction building plate for connection of two curved pieces of wood, such as in the assembly of a boat. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: The tensioner, invention I.

A. Tensioner with strings

a. Figure 10

B. Tensioner with tongs

a. Figure 11

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Marcella Watkins on 12/12/05 a provisional election was made without traverse to prosecute the invention III of a bone compression system, claims 28-39. Affirmation of this election must be made by applicant in replying

to this Office action. Claim 1-27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 28-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Concerning claims 29-39, if the independent claim is considered indefinite, all dependent claims are also indefinite. The applicant appears to be claiming multiple structures for the same element, an initial structure, an intermediate elastic structure and a final deformed structure. It is unclear as to which structure the applicant is directing the claims to. Claiming multiple structures to the same element is non-statutory subject matter within a structure claim. Additionally, since there are millions of different bones within the animal kingdom, the radius of curvature has an essentially millions of values as claimed, the number of possible dimensions is too numerous to ascertain. Suggested language: a plate **capable** of deforming from a preformed shape to an elastic state to a deformed state.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28-35, 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Coates (US Pat# 5423826). Coates discloses a plate (20) with a preformed shape having a radius of curvature (column 2, lines 55-57; Figure 3) and slots (159) at each end for insertion of arm end hook (161) (column 13, lines 9,10). The plate also contains fixation bores (41) at each end, which are interpreted as loops. All materials contain an elastic range of movement and a failure point where the deformations become permanent and therefore all plates will contain an elastic shape and a deformed shape if an adequate deformation mechanism is employed. Referring to figure 17 of Coates, the plate is fully capable of being deformed to an intermediate elastic shape and a final deformed shape by tightening the threaded locking rod (155) as necessary to achieve multiple radii of curvature which are capable of corresponding to various bone radii of curvatures. Coates also discloses a plate holder/guide that is capable of being a tensioner as described above. The plate holder includes a shaft as one of the at least two arms (151,152) or bridge portion (163) and base portions (157) that contain hooks (161, column 13, lines 9-10) which are also spatula members. The shaft/arms have at least one screw groove for the threaded locking rod (155) and are attached with a pivot bolt\* 160) as a hinge member. (column 13, lines 58-63) disposed along the longitudinal axis, the shafts second end being connected to the base (157) by pivot point dowels (165) which allows the bases (157) rotate about the pivot dowel while the shaft is stationary where the pivot dowel is a base shaft and resides in a cavity of the shaft.

Claims 28, 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Judet (US Pat# 4263904). Judet discloses a bracelet plate (1) with a radius of curvature (Figure 1) that is deformable and a tensioner (Figure 12) with shaft and base and at least two arms where any one of the holes along the shaft or arms are at least one screw groove. The plate contains the perforated loops (6,7) at each end of the plate where the at least two arms contain hook protrusions (14).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35 & 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Judet (US Pat# 4263904) in view of Rouse (US Pat# 2002021). Judet is explained supra. However Judet does not disclose a ball joint. Rouse teaches a spherical ball joint (col. 3, lines 22-30; page 3 first column) in the same field of endeavor or the analogous art of surgery and fracture repair for the purpose of having an arm movable in all directions as is provided by spherical ball joints. Rouse also discloses a shaft (5) that is rotatable independent of the base (8) where the base (8) may remain stationary. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of the ball joint, as taught by Rouse, to the clamp/tensioner as per Judet, in order to allow the arms of the tensioner the capability of additional degrees of freedom in order to rotate or turn the plate as needed.



**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ling, US Pat# 3840014- retractor; Sherwin, US Pat# 3750652- retractor; Ray, US Pat# 6458131- spinal apparatus.

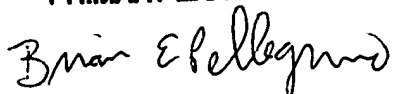
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Amareld, Jr. whose telephone number is 571-272-6170. The examiner can normally be reached on M-F 9am -5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RWA

**BRIAN E. PELLEGRINO**  
**PRIMARY EXAMINER**



Robert W Amareld, Jr.  
Examiner  
Art Unit 3738

